



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

HUNTON & WILLIAMS LLP
INTELLECTUAL PROPERTY DEPARTMENT
1900 K STREET, N.W.
SUITE 1200
WASHINGTON DC 20006-1109

COPY MAILED

NOV 27 2006

OFFICE OF PETITIONS

In re Application of
John C. HARVEY et al.
Application No. 08/459,788
Filed: June 2, 1995

ON PETITION

This is a decision on the petition filed October 26, 2005, under 37 CFR 1.181(a)(3) requesting the Director exercise his supervisory authority and overturn the decision of the Director, Technology Center 2600 (Technology Center Director), dated August 31, 2005, which refused to: (1) impose a schedule for the prompt examination of this application"; (2) declare that the application and related applications are "special, and treat them as such; (3) assign a new primary examiner to this and the related applications; (4) establish a committee to supervise the examination of this and the related applications to ensure that the examination is conducted in accordance with an accelerated schedule; (5) inform applicants whether their applications are on the internal PTO sensitive application warning system (SAWS) list; and (6) identify any other special review procedures or lists that this and other related applications may be subject to that a "normal" patent application would not be subject to.

The petition to overturn the decision of the Technology Center Director dated August 31, 2005, is **DENIED**¹.

BACKGROUND

The instant application was filed May 23, 1995 along with 328² related applications with identical disclosures filed between March and June 1995.

The application was amended twice prior to a first Office action being mailed on March 24, 1997.

An amendment was filed September 24, 1997.

On December 31, 1997 a final Office action was mailed.

Two more amendments were filed on March 2, 1998 and March 3, 1998.

On December 28, 1998 petitioners requested that prosecution be reopened under 37 CFR 1.129(a).

On June 19, 2002 an Administrative Requirement was imposed requiring petitioners to:

- (1) File terminal disclaimers in each of the related co-pending applications terminally disclaiming each of the other co-pending applications;
- (2) Provide an affidavit attesting to the fact that all claims in the co-pending applications have been reviewed by applicant and that no conflicting claim exists between the applications; or
- (3) Resolve all conflicts between claims in the identified co-pending applications by identifying how all the claims in the instant application are distinct and separate inventions from all the claims in the identified co-pending applications.

The requirement was deferred until the file is in condition for allowance.

On September 5, 2002 a non-final Office action was mailed.

On March 5, 2003 an amendment was filed.

On January 6, 2005 the application was suspended for a period of six months.

On March 7, 2005 a petition to invoke supervisory authority was filed.

On August 31, 2005 a decision denying the petition filed March 7, 2005 was mailed.

STATUTE, REGULATION, AND EXAMINING PROCEDURE

35 § U.S.C. 132(a) states:

- (a) Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. No amendment shall introduce new matter into the disclosure of the invention.

37 CFR 1.103(e) states:

(e) Notice of suspension on initiative of the Office. The Office will notify applicant if the Office suspends action by the Office on an application on its own initiative.

MPEP 707.02 states:

Any application that has been pending five years should be carefully studied by the supervisory patent examiner and every effort should be made to terminate its prosecution. In order to accomplish this result, the application is to be considered "special" by the examiner.

MPEP 708 states in part:

Each examiner will give priority to that application in his or her docket, whether amended or new, which has the oldest effective U.S. filing date. Except as rare circumstances may justify Technology Center Directors in granting individual exceptions, this basic policy applies to all applications.

MPEP 709 states:

Suspension of action at the initiative of the Office should be avoided, if possible, because such suspension will cause delays in examination, will increase pendency of the application, and may lead to a shortening of the effective patent term or, conversely, patent term extension, or adjustment, due to the suspension. Once a suspension of action has been initiated, it should be terminated immediately once the reason for initiating the suspension no longer exists, even if the suspension period has not expired. 37 CFR 1.103(e) provides that the Office will notify applicant if the Office suspends action in an application on its own initiative. Every suspension of action initiated by the Office will be limited to a time period of a maximum of 6 months. An examiner may grant an initial suspension of Office action on his or her own initiative, as in MPEP § 709.01 and MPEP Chapter 2300, for a maximum period of 6 months. A notification of suspension must be mailed to the applicant for each Office-initiated suspension of action, even for second or subsequent suspensions, and must include a suspension period (a maximum of 6 months). When the suspension period has expired, the examiner should take up action on the application or evaluate all possibilities for giving an action on the merits. For example, if a reference is still not available after waiting for six months, the examiner should try to find another source for the information or update the search to find another reference that can be used to make a rejection. If, in an extraordinary circumstance, a second or subsequent suspension is necessary, the examiner must obtain the TC director's approval (see MPEP § 1003) and

prepare another suspension notification with a suspension period (a maximum of 6 months). The notification for a second or subsequent suspension must be signed by the TC Director.

OPINION

Petitioners specifically request that the Director overturn the Technology Center Director's decision of August 31, 2005 and: (1) rescind the notice of suspension or require prompt examination of this application; (2) impose a schedule for the prompt examination of this application; (3) declare that the application and related applications are "special, and treat them as such"; (4) assign a new primary examiner to this and the related applications; and (5) establish a committee to supervise the examination of this and the related applications to ensure that the examination is conducted in accordance with an accelerated schedule.

With respect to the request to rescind the notice of suspension or require prompt examination of this application, petitioners state: (1) there is no justification for the Office's refusal to examine this application; (2) the Office is not giving this application the attention it is due based on their priority date in accordance with MPEP 708; (3) page 4 of the Technology Center Director's decision asserts that the application remains suspended, and thus, it appears that the Office considers, without proper authority, this application to be suspended indefinitely; (4) 35 U.S.C. § 132(a) states that if after receiving an Office action, "the applicant persists in his claim for a patent, ... the application shall be reexamined"; (5) according to MPEP 707.02 "[a]ny application that has been pending five years should be carefully studied by the supervisory patent examiner and every effort should be made to terminate its prosecution" and that the suspension is contrary to this; and (6) the Office guidelines with respect to Suspension of Action set forth in MPEP 709 have been disregarded including the fact that the official suspension expired in July 2005 and thus, a continuing *de facto* suspension of this application exists.

Initially, with respect to petitioners' argument that there is no justification for the Office's refusal to examine this application it is noted the Office has not refused to examine the application; in fact, an examination on the merits has begun as evidenced by the March 24, 1997 Office action and the two succeeding Office actions on the merits.

Additionally, petitioners have contributed to the lengthy prosecution as can be seen by their request to reopen prosecution under 37 CFR 1.129(a) on March 5, 1998. The Office has merely suspended prosecution of this application pending the outcome of USPTO tribunal review in two closely related applications and two reexamination proceedings. The outcomes of the prosecution in these related cases would have a profound effect on the prosecution of this and any other related applications. For instance, the outcomes of the prosecutions of the related applications not under suspension would effectuate, e.g., determinations as to the adequacy of the disclosures

under 35 U.S.C.112, the propriety of prior art rejections, respective priority dates of claimed subject matter, and the meaning of terms set forth in the claims. Given the extraordinary situation here, where petitioners have 111 applications pending with identical specifications and given the fact that petitioners have not denied that there is any overlap in these related applications, the outcomes of those related applications not under suspension would effect further prosecution of this application. Thus, petitioners have not shown the Technology Center Director clearly erred in holding that decisions in the applications not under suspension will have material impact in determining future action by the Office such as whether to allow or reject certain claims and will provide guidance necessary for further prosecution. While petitioners argue that this application may have allowable claims as only 35 U.S.C. 112 rejections remain and petitioners have responded to those rejections, the fact remains that the outcome of the related applications not under suspension will have an impact in determining the further prosecution of this application. As set forth in the Technology Center Director's decision on petition "[c]ontrary to petitioner's arguments, the outcome of the related reexamination proceedings have a direct bearing on the prosecution of this and the related applications...[R]elated pending applications that currently are under appeal have prosecution that is closely related to this and the other suspended files." As the court noted in In re Faust, 378 F.2d 966, 153 USPQ 813 (CCPA 1967) one of the most exceedingly difficult questions in patent law is whether the subject matter of the claims in one application is obvious in view of but one other application; here the USPTO is confronted with considering the claims of this application in view of over 100 other of petitioners' applications all based on the same disclosure. It follows that the likelihood of similarity of claimed subject matter arising in 2 or more of over 100 applications is even higher in this instance due to the common disclosure.

Next, petitioners argue that the Office is not handling this application in accordance with the procedures set forth in the MPEP. While MPEP 707.02 states that any application that has been pending five years should be considered special by the examiner, MPEP 708 states that the Technology Center Director may grant exception in rare circumstances as to the priority an examiner will give an application in his docket. Here it is noted that the application has special status, however, given that petitioners have 111 pending applications with identical specifications and given the fact that petitioners have not denied that any overlap exists, a rare circumstance exists which reasonably permits the Technology Center Director to grant an exception to this policy as to the priority in which the application will be given in an examiner's docket.

Finally, petitioners argue that the Office is not following policy with respect to suspending prosecution of an application. MPEP 709 states *inter alia* that: suspension of action should be avoided, if possible; once a suspension has been initiated, it should be terminated immediately once the reason for initiating the suspension no longer exists; the Office will notify applicant if the Office suspends action in an application on its own initiative (37 CFR 1.03(e)); every suspension of action initiated by the Office will

be limited to a time period of a maximum of 6 months; and that in an extraordinary circumstance, if a second or subsequent suspension is necessary, the notification must be signed by the Technology Center Director. As evidenced by the initial Office action in this application, the Office attempted to avoid suspension of this application; however, in view of the extraordinary circumstances set forth above with respect to this application and the related applications a suspension was reasonably deemed warranted by the Technology Center Director. Petitioners were informed of this decision in accordance with 37 CFR 1.103(e), the initial and subsequent suspension³ were signed by an appropriate official, and at no time was a period greater than 6 months set for the period of suspension. Additionally, the MPEP does not set forth all of the reasons for which a suspension of action may occur. Accordingly, the suspension of action was not inconsistent with Office policy. Therefore, when considering the totality of the circumstances as whole, including the complexity and overlapping nature of these 111 pending applications, along with the reasoning set forth above, the Office has followed appropriate procedures and has not been demonstrably arbitrary and capricious in the suspension of this application.

For the reasons set forth above, the Technology Center Director's decision to refuse petitioners' requests to: (1) require prompt examination of this application; (2) impose a schedule for the prompt examination of this application; (3) declare that the application and related applications are "special, and treat them as such" is not shown to be in clear error.

Next, the Technology Center Director's treatment of the request that the application be assigned a new and objective primary examiner, as the examiners previously assigned to this application have not conducted such a proper, prompt examination will be treated.

The gravamen of petitioners' complaint seems to be that the application is currently under suspension, and petitioners obviously disagree with the rejections contained in the last Office action. It should be noted that reasonable men can disagree as to whether a given claim is patentable and on what basis. See Lear, Inc. v. Adkins, 395 U.S. 653, 670, 162 USPQ 1, 8 (1969). A mere difference of opinion between the examiner and the applicant as to the patentability of one or more claims does not evidence bias or a lack of understanding on the part of the examiner, much less that his replacement is justified.

As noted in In re Ovshinsky, 24 USPQ2d 1241, 1251-2 (Comm'r Pats.1992), the issue is not whether the perceptions of an applicant regarding alleged bias are reasonable; rather the issue is: whether an applicant has demonstrated improper conduct, including bias or the appearance of bias, on the part of the examiner or Technology Center Director. A full investigation of the facts set forth in the petition, as well as a full consideration of the entire record of this application fails to reveal bias or improper

conduct on the part of either the Technology Center Director or the examiner, and as such, there is no reversible error in the Technology Center Director's decision.

For the above reasons, the Technology Center Director's decision to refuse petitioners' request to assign a new primary examiner to this and the related applications is upheld.

Finally, with respect to the request to establish a committee to supervise the examination of this and the related applications to ensure that the examination is conducted in accordance with an accelerated schedule, petitioners' assert that such action is required because under the extraordinary circumstances of this application the current supervision has not produced an examination in accordance with the established procedures of the Office.

It is for the Technology Center Director, and thus, the USPTO, and not applicant to determine how USPTO resources will be allocated to a given application.

For the above reasons, the Technology Center Director's refusal to establish a committee to supervise the examination of this and the related applications to ensure that the examination is conducted in accordance with an accelerated schedule is upheld.


DECISION

A review of the record indicates that the Technology Center Director did not abuse his discretion or act in an arbitrary and capricious manner in the petition decision of August 31, 2005. The record establishes that the Technology Center Director had a reasonable basis to support his findings and conclusion.

The petition is granted to the extent that the decision of the Technology Center Director of August 31, 2005 has been reviewed, but is denied with respect to making any change therein. As such, the decision of August 31, 2005 will not be disturbed. The petition is **denied**.

This application is being referred to Technology Center 2600 for further processing.

Telephone inquiries concerning this decision should be directed to David A. Bucci at (571) 272-7099.


John Love
Deputy Commissioner for
Patent Examination Policy (Acting)

Cp

¹ This decision may be viewed as a final agency action within the meaning of 5 U.S.C. § 704 for purposes of seeking judicial review. See MPEP 1002.02

² 111 applications remain pending. This same petition was filed in application nos. 08/447,447; 08/488,383; 08/459,788; 08/472,066; 08/487,410; and 08/487,411.

³ On pages 3 and 4 of the instant petition, petitioners' acknowledge the August 31, 2005 decision of the Technology Center Director is in effect an additional suspension.